

Appln. No.: 10/691,841
Amendment dated July 5, 2005
Reply to Office Action of April 5, 2005

REMARKS/ARGUMENTS

The Office Action of April 5, 2005 has been carefully reviewed and these remarks are responsive thereto. Claims 10, 17, 24, 31, and 33 have been amended, no claims have been cancelled, and no new claims have been added. Claims 1-55 thus remain pending in this application. Reconsideration and allowance of the instant application are respectfully requested.

The Office Action of April 5, 2005 rejected this application under the judicially created doctrine of obviousness-type double patenting over claims 12, 19, 24, and 33 of the application 10/729,841. With this amendment Applicants are filing a terminal disclaimer with regard to application 10/729,841 (Samji *et al.*). Accordingly, Applicant respectfully submits that all claims in this application are now allowable, as further discussed below.

Rejections Under 35 U.S.C. § 102

Claims 1-55 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Matsubara (U.S. Patent Appl. Publ. No. US 2003/0225796 A1). Applicants respectfully traverse this rejection for at least the following reasons.

In order to reject a claim as anticipated under 35 U.S.C. §102, a single prior art reference must teach every aspect of the claimed invention. MPEP § 706.02. With respect to independent claims 1 and 36, Matsubara does not describe a method comprising creating a list or virtual folder "on the sharer's machine." Rather, Matsubara creates virtual directories which reside on the central system server, not on the sharer's machine. Matsubara, Abstract. Matsubara, in figures 3 and 4, and in the corresponding paragraphs 0039-0051, refers to a single file table and single directory table residing in a system server, which are accessible to sharee and sharer clients through network resource browser (NRB) software. Matsubara further describes the communications that the sharee must have with the system server, to retrieve file information and user credentials from these tables, before accessing the sharer's computer. Matsubara, paragraph 0062. Thus, Matsubara does not describe lists or virtual folders "on the sharer's machine," as recited in claims 1 and 36. Dependent claims 2-9, 37-44, 49, and 55 are allowable for at least the same reasons as their respective base claims, as well as based on the additional features recited therein.

Appln. No.: 10/691,841
Amendment dated July 5, 2005
Reply to Office Action of April 5, 2005

Applicants have similarly amended independent claims 10, 17, and 24 to describe a sharing method and computer-readable media comprising lists or virtual folders that reside "on the sharer's machine." As stated above, the virtual directories created by Matsubara reside on the central system server, not on the sharer's machine. Matsubara, Abstract. Thus, Applicants respectfully request that the rejections of these claims be withdrawn. Additionally, dependent claims 11-16, 18-23, 25-30, 45-48, and 50-53 are allowable for at least the same reasons as their respective base claims, as well as based on the additional features recited therein.

Applicants have also amended independent claim 31 to describe a media that allows the sharee to access the items *directly* through the sharer's computer. In contrast, Matsubara maintains its virtual directories in the system server, and requires sharee clients to first interact with the system server before gaining access to the sharer. Matsubara, Abstract. Matsubara sharees must use NRB software to interact with the system server to browse for sharable files, learn the location of the files, and receive user credentials to access the files. Matsubara, paragraph 0062. Thus, Matsubara sharees can not access items *directly* through the sharer's computer, as recited in claim 31. Dependent claims 32-35, and 54 are allowable for at least the same reasons as claim 31, as well as based on the additional features recited therein.

With respect to claims 5, 6, 7, 13, 14, 20, 21, 27, 28, 32, 33, 40, 41, and 42, Matsubara does not describe creating a dynamic list of sharable items. Matsubara describes merely "providing and maintaining a virtual directory." Matsubara, Abstract. Matsubara does not mention the term "dynamic" or "dynamic list," and does not describe any dynamic functionality as part of its virtual directory structure. In contrast, the Applicants state, "a dynamic list gathers a set of items based on a scope and a set of criteria." Application, Abstract. The Applicants' specification goes on to describe functionality that separates dynamic lists from virtual directories:

If any items in the dynamic list have their properties changed such that they no longer meet the criteria of the dynamic list, then these items are appropriately re-permissioned. In the same way, if any items that do not belong to the dynamic list change such that they fall into the scope and meet the criteria of the dynamic list, they are also re-permissioned to grant access to the users with which the dynamic list is shared. Application, p. 4-5.

Appln. No.: 10/691,841
Amendment dated July 5, 2005
Reply to Office Action of April 5, 2005

In contrast, Matsubara does not use a defined scope or set of criteria to select the items to be put into its virtual directories. Rather, in Matsubara, individual sharers decide to add and remove files from the virtual directories using the client NRB software. Matsubara, paragraphs 0068-0070. Similarly, Matsubara does not allow items to be re-permissioned when their properties are changed. Thus, Matsubara does not describe dynamic lists, but mere virtual directories without a defined scope or set of criteria, and without the functionality for dynamic re-permissioning that is part of the Applicants' invention.

With respect to claims 43, 45, and 47, Matsubara does not define an order for the items within its virtual directories. According to the Application, the items in a static list have a specific order, and lists can be pivoted to change the view presented to the user. Application, Abstract, p. 13. Matsubara never mentions ordering the items in its virtual directories. Indeed, the term "order" is never found in Matsubara. In Matsubara, the virtual directory items would presumably be displayed either in alphabetical order or in chronological order with respect to the time the sharers placed the items in the folder. Matsubara, however, does not state which of these orders the sharable files will be found in, nor does it mention any other possible ordering system for its virtual directory items. Thus, Matsubara does not define an order for the plurality of referenced items, as is recited in claims 43, 45, and 47.

Similarly, with respect to claims 44, 46, and 48, Matsubara does not describe the annotation of the list items in its virtual directories. As the Applicants state:

In accordance with another aspect of the invention, a static list comprises a folder of items that are in a specific order and that can optionally have annotations placed on each item. These annotations are not part of the item, but belong to the actual list. Application, p. 3.

Webster's Third New International Dictionary (2002) defines annotate as "to make or furnish especially critical or explanatory notes usually on a literary work or subject." Matsubara does not contain the word "annotate" or "annotation," nor does it describe a sharing system which allows sharers or sharees to make notes on its sharable virtual directory items. Matsubara, figures 3-4. The Office Action indicates that Matsubara's access control lists, which define user permissions on each item in the directory table and file table, are the equivalent of annotations. The Applicants respectfully disagree. The access control list fields are incapable of holding

Appln. No.: 10/691,841
Amendment dated July 5, 2005
Reply to Office Action of April 5, 2005

notes or comments about the list items, these fields only hold information about which sharees are able to access the item and what level of permissions each sharee has on the item. Matsubara, paragraphs 0043, 0073. Thus, Matsubara does not describe a sharing system comprising "annotation," as is recited in Applicants' claims 44, 46, and 48.

CONCLUSION

All rejections having been addressed, applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the examiner is requested to contact the undersigned at (202) 824-3153.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated this 5th day of July, 2005.

By: /Ross Dannenberg/
Ross Dannenberg, Registration No. 49,024

1001 G Street, N.W.
Washington, D.C. 20001-4597
Tel: (202) 824-3000
Fax: (202) 824-3001

RAD/mmd